

There are two criteria for a proper restriction requirement between patentably distinct inventions. First, the inventions must be independent or distinct as claimed. Second, there must be a serious burden on the Examiner if restriction is not required. M.P.E.P. § 803. Here, the Office Action fails to meet the second criterion. The Office Action does not allege that examination of the invention of both groups would constitute an undue burden, nor does the Office Action provide any reasoning to suggest the same. The Office Action merely points out that the invention of Group I is classified in a separate subclass of Class 424.

Under the present circumstances, assignment of the two groups of claims to separate search subclasses cannot constitute an undue burden. The present application is a CPA and both groups of claims were pending in the application prior to the filing of the CPA Request. Accordingly, a complete prior art search has already been conducted and completed. Moreover, even if a new prior art search were to be required, searching two subclasses does not constitute a serious burden on the Examiner at least because the unresolved issues (based on the rejections set forth in prior Office Actions) in the prosecution of the subject application are the same for both groups of claims. Accordingly, applicants respectfully submit that the restriction requirement is improper and should be withdrawn.

The Requirement For Election Of Species

The Office Action states that claims 1, 5-15, 19-27, and 31 are generic to a plurality of patentably distinct species comprising compositions containing polymers with a biopolymeric backbone selected from the group consisting of an oligonucleotide, a nucleic acid, an antibody, or a fragment thereof, a protein containing a recognition sequence, an antichemotactic agent, and a hormone. Similarly, the Office Action states that the invention comprises a plurality of species which incorporate separate “X”-group linkages. The Office Action accordingly required the election of a single disclosed species.

In response to the election of species requirement, applicants elect with traverse the species of formula VIII, wherein R₁ and R₂, together with the nitrogen atom to which they are bonded, form a piperazino group as the nitric oxide-releasing group and a nucleic acid as the biopolymeric backbone. However, an election of species requirement is unnecessary here because the rejections that the Office has maintained, and which required the filing of a CPA Request, do not pertain to a single chemical species of the invention. Rather, the rejections that the Office has maintained pertain to the full scope of the claimed invention. Therefore, the prosecution of the subject patent application will not be expedited or

In re Appln. of Saavedra et al.
Serial No. 08/837,812

simplified if the requirement for an election of species is maintained. Therefore, the requirement for an election of species should be withdrawn.

Conclusion

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,


Bruce M. Gagala, Registration No. 28,844
One of the Attorneys for Applicant(s)
LEYDIG, VOIT & MAYER, LTD.
Two Prudential Plaza, Suite 4900
180 North Stetson
Chicago, Illinois 60601-6780
(312) 616-5600 (telephone)
(312) 616-5700 (facsimile)

Date: June 21, 1999

CERTIFICATE OF MAILING

I hereby certify that this RESPONSE TO RESTRICTION REQUIREMENT (along with any documents referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

Date: June 21, 1999
161192am5

